

REMARKS/ARGUMENTS

In response to the Office Action mailed July 23, 2004, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. Claims 1, 5, 8 and 12 were amended, no claims have been added, and claims 4 and 11 were cancelled without prejudice so that claims 1, 2, 5-9 and 12-15 remain pending. No new matter has been introduced.

Claims 1-2 and 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1 025 813 to Wilson et al. (Wilson) in view of U.S. Patent Number 6,689,120 to Gerdts (Gerdts). Claims 1, 2, 4-9 and 11-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,726,712 to Raeder-Devens et al (Raeder) in view of U.S. Patent Number 6,689,120 Gerdts. Claims 1, 2 and 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,287,329 to Duerig et al. (Duerig) in view of Gerdts. Claims 8, 9 and 11-15 were rejected as being unpatentable over Duerig in view of Gerdts and Raeder. These rejections are respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. In

re Vaeck, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.”

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”

None of the references, whether taken alone or in combination disclose a delivery apparatus for a self-expanding stent that comprises stainless steel wire that is substantially rectangular and has a width of 0.003 inches and a height of 0.001 inches. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Applicants would be willing to interview the present case if the Examiner so desires. Accordingly, the Examiner is invited to call the undersigned at (732) 524-2518 if such a call would facilitate the prosecution of this application.

A favorable action on the merits is earnestly solicited.

Serial No. 09/884,728

The Commissioner is hereby authorized to charge any fee pursuant to 37 C.F.R. §116 and any other fee that may be due to Deposit Account No. 10-750/CRD-0940/CJE.

Respectfully submitted,

By: 
Carl J. Evens
Reg. No. 33,874

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2518
Dated: October 18, 2004